

REMARKS

In the Office Action identified above, the Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Block et al. (U.S. Patent Publication No. 2003/0050976) in view of Shtivelman (U.S. Patent No. 6,346,952).

By this amendment, Applicants have amended claims 1, 7, 13, 19, 21, 23, and 24. Claims 1-24 remain pending. Based on the following reasoning, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103.¹

I The Rejection of Claims 1-24 Under 35 U.S.C. § 103

Applicants respectfully traverse the rejection of claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Block et al. in view of Shtivelman because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Independent claim 1 recites a combination including, *inter alia*, “summary message managing means for managing summary messages which summarize and include a conclusion associated with messages accumulated in the virtual community for respective topics.” This element of claim 1 is not taught or suggested by Block et al. and Shtivelman, either alone or in any reasonable combination.

The Examiner admitted that Block et al. fails to teach “summary message managing means for managing summary messages which summarize messages accumulated in the virtual community for respective topics.” (OA at 3). Therefore, Block et al. certainly fails to teach or suggest “summary message managing means for managing summary messages which summarize and include a conclusion associated with messages accumulated in the virtual community for respective topics,” as recited in claim 1. Shtivelman does not cure the deficiencies of Block et al. Shtivelman is directed to a method and apparatus for summarizing previous threads in a communication-center chat session. (Abstract). To this end, Shtivelman teaches parsing “keywords related to query/response pairs” and displaying them in a “dialog summary column.” (FIG. 8 and Col. 20, lines 7-54). However, these passages fail to teach “summary message managing means for managing summary messages which summarize and include a conclusion associated with messages accumulated in the virtual community for respective topics,” as recited in claim 1. That is, parsed keywords cannot constitute the “summary messages” as recited in the claims.

Accordingly, the cited references fail to teach or suggest each and every element of claim 1. For at least this reason, no *prima facie* case of obviousness has been established and claim 1 is allowable over Block et al. and Shtivelman.

Independent claims 7, 13, 19, 21, and 23, although of different scope, recite elements similar to that discussed above with regards to independent claim 1. Applicants, therefore, request the Examiner to withdraw the rejection of independent claims 7, 13, 19, 21, and 23 for at least the same reasons discussed above with respect to claim 1.

Claims 2-6, 8-12, and 14-18 depend from independent claims 1, 7, and 13, respectively. As explained, claims 1, 7, and 13 recite elements not disclosed by Block et al. in view of Shtivelman. Accordingly, claims 2-6, 8-12, and 14-18 are allowable over Block et al. in view of Shtivelman for at least the same reasons as claims 1, 7, and 13.² Applicants, therefore, respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Independent claim 20 recites a combination including *inter alia*, "providing a search result list consisting of message search results limited on the basis of a combination of the community type of the virtual community which is to undergo search and the member type of the client terminal as the search request source for the virtual community." This element of claim 20 is not taught or suggested by Block et al. and Shtivelman, either alone or in any reasonable combination. In the passages cited by

² As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

the Examiner, Block et al. teaches displaying “all messages sent from individuals who are also Members of the website and from the Administration of the different Teams and Leagues in which the individual is a Participant” after the individual requests the system to display “My Messages.” (Paragraphs 121-22). In addition, Block et al. teaches a “Team Finder” or “League Finder” search by a user. After the search, the user is “given a range of options relevant to their membership status.” (Id.) However, these teachings do not constitute a teaching or suggestion of the search process in the manner recited in claim 20. Indeed, the “search results are not limited on the basis of a combination of the community type of the virtual community which is to undergo search and the member type of the client terminal as the search request source for the virtual community,” as recited in independent claim 20.

Independent claims 22 and 24, although of different scope, recite elements similar to that discussed above with regards to independent claim 20. Applicants, therefore, request the Examiner to withdraw the rejection of independent claims 22 and 24 for at least the same reasons discussed above with respect to claim 20.

II Conclusion

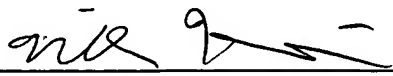
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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